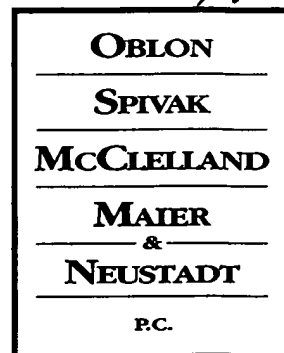




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TECHNOLOGY CENTER R3700



Docket No.: 216369US2DIV

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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RE: Application Serial No.: 09/995,565

Applicants: Satoshi HIRANO

Filing Date: November 29, 2001

For: A HEAT STORAGE DEVICE

Group Art Unit: 3743

Examiner: McKINNON, T

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO ELECTION REQUIREMENT  
REQUEST FOR EXTENSION OF TIME (3 MOS.)**

Our check in the amount of \$920.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Gregory J. Maier  
Registration No. 25,599

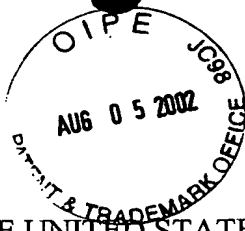
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216369US2DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

:

Satoshi HIRANO

: EXAMINER: MCKINNON, T

SERIAL NO: 09/995,565

:

FILED: NOVEMBER 29, 2001

: GROUP: 3743

FOR: A HEAT STORAGE DEVICE

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TECHNOLOGY CENTER R3700

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER OF PATENTS  
WASHINGTON, DC 20231

SIR:

In response to the Election of Species Requirement stated in the Official Action dated April 5, 2002, Applicant provisionally elects Figure 1 (Figures 2 and 3), and identify Claim 4 as readable on the elected species.

Applicant respectfully traverses the outstanding election requirement for several reasons.

First, the outstanding Office Action asserts that "[t]his application contains claims directed to the ... patentably distinct species of the claimed invention...." However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

The outstanding Election Requirement merely provides a conclusory statement and does not present particular reasons for such a holding. Hence, Applicant respectfully submits that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicant further traverses the Election Requirement.

Furthermore, MPEP §803 states the following:

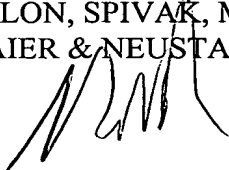
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Claims 3 and 4 of the present application are both directed to a heat storage device. Thus, it appears that all claims in the present application are part of an overlapping search area and that a search for Claim 4 would necessarily include a search directed to Claim 3 readable on the non-elected species as well. Applicant therefore respectfully submits that there is no undue burden on the Examiner to search all the claims under MPEP §803, and traverse the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 3-9 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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